

**REMARKS**

By this Amendment, claims 1, 65, 89 and 90 have been amended. No claims have been cancelled or newly added. Support for the instant amendments is provided throughout the as-filed application. No new matter has been added. Thus, claims 29, 30, 32, 33, 35, 36, 38, 41-56, and 58-92 remain pending.

In view of the foregoing amendments and the following comments, allowance of all the claims pending in the application is respectfully requested.

**REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 89 and 90 were rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as their invention. Applicant has amended claims 89 and 90 to depend from claim 29. Accordingly, the withdrawal of this rejection is respectfully requested.

**REJECTIONS UNDER 35 U.S.C. § 103**

**In the Office Action:**

I. Claims 29, 30, 35, 36, 38, 41-49, 52-56, 65-74, 77-81, and 89-92 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 7,206,778 to Bode, *et al.* (hereinafter “Bode”) in view of U.S. Patent No. 6,718,366 B2 to Beck, *et al.* (hereinafter “Beck”), and further in view of U.S. Patent No. 5,815,830 to Anthony (hereinafter “Anthony”) and U.S. Provisional Patent Application Serial No. 60/482,171 to Song, *et al.* (hereinafter “Song”);

II. Claims 58-61, 63, 82-85, and 87 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bode in view of Beck, Anthony, and Song, and further in view of U.S. Patent Application Publication No. 2001/0049688 A1 to Fratkina, *et al.* (hereinafter “Fratkina”);

III. Claim 32 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bode in view of Beck, in view of Anthony, and further in view of Song and U.S. Patent No. 6,976,018 to Teng, *et al.* (hereinafter "Teng");

IV. Claim 33 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bode in view of Beck, in view of Anthony, and in further view of Song and U.S. Patent No. 7,185,001 to Burdick, *et al.* (hereinafter "Burdick");

V. Claims 50, 51, 75, and 76 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bode in view of Beck in view of Anthony and in further view of Song and the Examiner's "Obviousness" allegation; and

VI. Claims 62, 64, 86, and 88 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bode in view of Beck in view of Anthony and in further view of Song and U.S. Patent No. 5,873,056 to Liddy, *et al.* (hereinafter "Liddy").

Applicants disagrees with the propriety of these rejections. However, solely in an effort to expedite prosecution and without acquiescing to the propriety of the rejections, Applicants have amended independent claims 29 and 65 to further clarify aspects of the claimed invention.

Independent claim 29 and 65 as amended recite, *inter alia*, the features of:

automatically determining from the monitored communication, in real-time, one or more topic words associated with the monitored communication; and

automatically searching the at least one data source in real-time during the communication for the one or more topic words appearing in the monitored communication to generate search results for documents relevant to the context or the one or more key topics of the communication.

[emphasis added].

The aforementioned rejections are improper because Bode, Beck, Anthony and Song, whether taken alone or in combination, do teach or otherwise render obvious *at least* the above-emphasized features of amended claims 29 and 65.

In particular, the rejections are improper because: (i) Bode "teaches away" from the claimed invention, and thus Bode should not have been used in the asserted combination of references; (ii) the Examiner concedes that Beck and Anthony do not teach or suggest various feature of the claimed invention; and (iii) the relied-upon passages of Song do not teach or suggest (a) automatically determining from the monitored communication, in real-time, one or more topic words associated with the monitored communication; and (b) automatically searching the at least one data source in real-time during the communication for the one or more topic words appearing in the monitored communication to generate search results for documents relevant to the context or the one or more key topics of the communication.

**I. Bode "teaches away" from the claimed invention, and thus Bode should not have been used in the asserted combination of references.**

A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness. *In re Gurley*, 27 F.3d 551, 554 (Fed. Cir. 1994). The Federal Circuit held that a reference "teaches away" if one skilled in the art, "upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *Id.* at 553. Moreover, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983).

As previously pointed out, the features that the Examiner has continuously relied upon Bode to allegedly teach are apparently related to a customer relationship management (CRM) system. [See Bode, col. 4, lines 55-56 (the features discussed in U.S. Patent No. 6,711,585, which are described by Bode at column 5, lines 6-15, relate to a CRM system); col. 7, lines 35-40 (noting that the search engine 410 shown in Figure 4 uses "a text query and/or other information obtained during a user's session"); col. 9, lines 48-52 (noting the same for the

method illustrated in Figure 5)]. Such systems appear at most to monitor communications responses of the user in response to automated querying by the CRM system to guide the user to user-requested information. CRM systems of this type, however, are used to dispense with, or minimize, the need for human resources. [See Bode, col. 1, lines 31-34]. This, however, is inapposite to the recited invention of claims 29 and 65 (i.e., two human individuals communicating and an automated system monitoring that communication between the individuals).

That being said, the Examiner erred by continuing to rely upon Bode's teachings of a CRM system in the asserted combination of references used to support the obviousness rejection. *See KSR Int'l Co. v. Teleflex, Inc.*, 82 USPQ2d 1385, 1395 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful mean of combining them is more likely to be nonobvious.")].

For *at least* this reason, the rejection of claims 29 and 65 is improper and must be withdrawn.

In addition, the Examiner *concedes* that Bode does not disclose "... the additionally recited features of automatically monitoring, via the first interface, a communication *between a user associated with the remote client and at least one other individual.*" [Office Action, page 4, emphasis in original].

**II. The Examiner concedes that Beck and Anthony do not teach or suggest various features of the claimed invention.**

The Examiner additionally *concedes* that the asserted combination of Bode, Beck and Anthony does not disclose:

automatically determining 'from the monitored communication, and in real-time', one or more topic words associated with the communication and automatically search at least one data source 'in real-time during the communication' for the one or more topic words appearing in the monitored communication' to generate

search results for information relevant to the context or the one or more key topics of the communication.

[Office Action, page 7, emphasis in original].<sup>1</sup>

Moreover, if these references do not teach generating "search results for information relevant to the context or the one or more key topics of the communication," as *acknowledged* by the Examiner, then it *must* also follow that they do not teach generating "search results for documents relevant to the context or the one or more key topics of the communication," as amended claims 29 and 65 recite.

The relied-upon passage of Song do not overcome these deficiencies either, as discussed below.

III. The relied-upon passages of Song do not teach or suggest (a) automatically determining from the monitored communication, in real-time, one or more topic words associated with the monitored communication; and (b) automatically searching the at least one data source in real-time during the communication for the one or more topic words appearing in the monitored communication to generate search results for documents relevant to the context or the one or more key topics of the communication.

In the Office Action, the asserts that page 143, ¶ 7 of Song allegedly discloses the additional features of: automatically determining 'from the monitored communication, and in real-time', one or more topic words associated with the communication and automatically search at least one data source 'in real-time during the communication' for the one or more topic words appearing in the monitored communication' to generate search results for

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<sup>1</sup> The Examiner states that the references do not "expressly" disclose these features. If is not clear, though, whether the Examiner believes that these features might be "inherently" disclosed. However, since the Examiner provides no evidence or basis in fact to show that these features are "necessarily present" in the reference(s) as required to support a finding of inherency, Applicant will assume that these features are not inherently disclosed therein either. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

information relevant to the context or the one or more key topics of the communication. [Office Action, page 8].

However, the relied-upon passage of Song does not teach or suggest at least the features of: automatically determining from the monitored communication, in real-time, one or more topic words associated with the monitored communication; and automatically searching the at least one data source in real-time during the communication for the one or more topic words appearing in the monitored communication to generate search results for documents relevant to the context or the one or more key topics of the communication, as amended claims 29 and 65 recite. For instance, Song states:

COTA Agent studies and notes ***storage pathways*** based on all documents' key words, sender, creator, department, divisional information etc. COTA Agent analyzes the user's ***storage methodology*** over time and begins to make suggestions based on a cross reference of the above information/metadata and the user's COTA system. An email from a GM Purchasing Agent requesting a proposal on Widgets would alert COTA agent in the following ways. 1) The sender is a Client of the receiver. 2) A Key Word search of the title and text indicates that the content refers to Widgets and Proposals. 3) A cross reference of the receiver's COTA File Folder and Document Titles reveals an exact Folder Title match: 1. Clients – GM – Widget Project – Proposals. 4) A secondary scan of actual document's body content reveals a close match between the incoming document and other documents in the receiver's GM Widget Projects – Proposal Folders. 5) ***Previous correspondence from the sender have been placed in a particular place by the user.*** 6) Before the user is done reading the first sentence of the mail, COTA agent offers several optional ***storage locations*** for the user's consideration. 7). The user simply clicks on the option that best representative where the ***document should be stored*** and ***COTA Agent places the document in that location.*** This improves the accuracy of the ***storage*** while reducing the cognitive chore of ***determining where the file should be best located for future use.***

[Song, page 143, ¶ 7, emphasis added].

The relied-upon passage of Song therefore does not teach “automatically determining from the monitored communication, in real-time, one or more topic words associated with the monitored communication.” Instead, this passage of Song teaches that “[a] Key Word search of the title and text indicates that the content refers to Widgets and Proposals.” (emphasis added). The Key Words searched in Song are apparently predetermined prior to any searching, and thus not determined, from the monitored communication, as the claims recite.

Additionally, the relied-upon passage of Song does not teach “automatically searching the at least one data source in real-time during the communication for the one or more topic words appearing in the monitored communication to generate search results for documents relevant to the context or the one or more key topics of the communication.” (emphasis added). At most, this passage of Song teaches determining the data source (i.e., storage location) where to store the email (or other documents).

And, assuming that the asserted combination of references is proper (which Applicants do not concede), this would require the user to manually parse through the identified storage location, during the communication, to determine documents relevant to the context or the one or more key topics of the communication. Applicants’ claimed invention, on the other hand, does not require users to do this.

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For *at least* the reason that the cited portions of Bode, Beck, and Anthony, either alone or in combination, do not disclose, teach, or otherwise render obvious each and every claim aspect, the rejection of independent claims 29 and 65 is improper and must be withdrawn. Claims 30, 35, 36, 38, 41-49, 52-56, 58-61, 63, 66-74, 77-85 and 87-91 depend from claims 29 and 65, respectively and therefore are also patentable over the cited portions of the relied upon references for the reasons noted above with respect to claims 29 and 65, as well as for the features they recite individually.

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**CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

If an extension of time is necessary to prevent abandonment of this application, then such an extension of time is hereby petitioned for under 37 C.F.R. §1.136(a). Any fees required (including fees for net addition of claims) are hereby authorized to be charged to **Deposit Account No. 122158 (Ref. No. LOT9-2001-0017-US1//042846-0312967)**.

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